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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,413	11/13/2001	Kiyoshi Hayashi	10873.836US01	2962

7590 02/15/2006
HAMRE, SCHUMANN, MUELLER & LARSON , P.C.
P.O. BOX 2902-0902
MINNEAPOLIS, MN 55402

EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/008,413	Applicant(s) HAYASHI ET AL.	
	Examiner Julian Mercado	Art Unit 1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

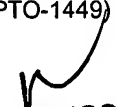
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 26-32.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


PATRICK JOSEPH
SUPERVISORY PATENT EXAMINER

Advisory Action

This advisory action is responsive to applicant's request for reconsideration filed January 18, 2006.

Applicant's amendment will be entered upon filing of a notice of appeal and an appeal brief. The examiner notes that independent claim 26 has been amended to incorporate the subject matter of dependent claim 33 (now cancelled). As claims 26-33 were given its full consideration in the prior Office action, the rejection of pending claims 26-32 is maintained for the reasons of record.

Applicant's arguments have been fully considered, however they are not found persuasive.

With respect to the numerical limits on the solubilities for the hardly-soluble cobalt compounds and easily soluble cobalt compounds, which applicant appears to assert was not taken into account in the prior Office action, the examiner maintains the reasons set forth in the April 29, 2005 Office action. The examiner maintains that as Uramoto et al. teaches a cobalt hydroxide and cobalt monoxide, these compounds would inherently possess the claimed solubilities. As to no suggestion in the reference that any steps were taken that would have produced a hardly-soluble cobalt compound, applicant is reminded that "[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

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Applicant submits that “[b]oth cobalt monoxide and cobalt hydroxide... have solubilities in the easily-soluble range” and that “the reference in no way teaches the presence of any other material that could be considered a hardly-soluble cobalt compound.” (remarks on page 4) In reply, and as set forth in the prior Office action, it appears to the examiner that this argument is premised on the process by which each of the cobalt compounds are made. Claim 26, however, merely recites the solubilities as a physical property of the cobalt compounds. Notwithstanding, the claimed product appears to be the same or similar to the prior art product insofar as Uramoto et al. teaching an alkaline battery having both cobalt hydroxide and cobalt monoxide. See the Abstract. For purposes of claim differentiation, the disclosed cobalt monoxide is considered readable on the claimed “at least one selected from cobalt metal, cobalt hydroxide, *cobalt monoxide*, and cobalt sulfate”, while cobalt hydroxide is maintained as being readable on the claimed hardly-soluble cobalt compound. It is maintained that absent of a showing by applicant that the claimed invention distinguishes over the reference, the cobalt hydroxide and cobalt monoxide compounds in Uramoto et al. would naturally flow to have, inherently, the same solubilities and specific gravity values as claimed. *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) and *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990) In reply to applicant’s assertion that the present record provides no reasonable basis for either of these compounds qualifying as hardly-soluble cobalt compounds, the examiner maintains the reasons set forth in the April 29, 2005 Office action, i.e. “the specification is understood to disclose that the hardly-soluble compound... consists of cobalt hydroxide.” (specification on page 5 line 1-2, page 6 line 2 and line 24, as cited in the Office action on page 2 thereof) Applicant appears to counter this position taken by the Office in asserting that “cobalt hydroxide is not a hardly-soluble cobalt

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compound and becomes a hardly-soluble cobalt compound only when some action is taken, e.g. the treatment steps discussed in the present specification and listed in the dependent claims.” (remarks on page 5) For example, applicant’s remarks state that the higher solubility cobalt compound “may be a cobalt metal, cobalt hydroxide, cobalt monoxide, and cobalt sulfate, where such cobalt compound may be provided *without the treatment* of the former cobalt compound...” and that the “cobalt hydroxide, after being subjected for instance to any of the above *treatments*, results in a cobalt compound that is different from the starting material.” (emphasis added) However, the examiner notes that there is no evidence on the record that applicant’s process, exclusively, results in the claimed hardly-soluble cobalt compound. Indeed, Figures 1-3 of the present specification support a hardly-soluble compound, but no evidence on the record has established an unobvious difference between the claimed product and the prior art product. See *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

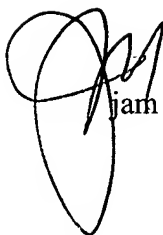
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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